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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/227,593	01/08/99	BESSE	M 730.010US1

021186 IM22/0215
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EXAMINER

TOOMER, C

ART UNIT

PAPER NUMBER

1721

DATE MAILED:

02/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/227593

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/9/99
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6, 8-16, 18-30 is/are rejected.
- ☒ Claim(s) 7 & 17 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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This Office action is in response to the amendment filed November 9, 1999 in which claims 1-3, 6-7, 10-11, 16-17 were amended and claims 21-30 were added.

Response to Amendment

The objection to the specification is maintained. The passage which Applicant refers to is not sufficient to support the limitations of claims 2, 3, 12 and 13. It is suggested that applicant insert these limitations in an appropriate place in the specification.

The Double Patenting rejection is withdrawn in view of the filing of a terminal disclaimer.

The rejection of the claims 1-11 under 35 U.S.C. 112, first paragraph is withdrawn in view of Applicants amendment to the claims.

The rejection of claims 6, 16, 7 and 17 under 35 U.S.C. 112, second paragraph, is withdrawn in view of Applicant's amendment and arguments. The rejection of claim 10 is maintained because while Applicant defined "EO", it is still not clear what Applicant is claiming. Does Applicant mean that there are 5 EO units as the alkoxylated group of the phosphate? Clarification is required.

Claims 10 and 20 are still rejected under 35 U.S.C. 112, second paragraph because Applicant has not set forth that the composition "further comprises" the additional components which are recited in these claims but not in the base claims.

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Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the Original filed specification that Applicant intended to exclude fatty acid components.

Claims 1-6, 8-9, 11-16, 18-19 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despo (US 5,391,308) in view of Liu (US 5,244,589) for the reason of record.

Applicant's arguments have been considered but are not deemed to be persuasive.

Applicant argues the prior art teaches fatty acid based lubricants whereas the present invention is directed to organic phosphate ester lubricants. Applicant argues that Despo uses the phosphate compound as stress cracking inhibiting agents and not as lubricants.

It should first be pointed out that applicant's base claims do not contain proportions. In the absence of the proportions, the metes and bounds of the claims cannot be ascertained. Secondly, Applicant's claims, as newly written, still read on the prior art. The claim term "comprising" does not exclude fatty acids being present in the composition in a major amount, nor does the claim language "consisting essentially of" exclude the presence of fatty acids. Applicant has provided no data to show that the presence of fatty acids changes the basic characteristics of the lubricant.

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Third and finally, the proportions recited in the dependent claims are encompassed by Despo because Despo teaches the phosphates are present in the composition at an amount of 0.10 to 15%.

Claims 7 and 17 are allowable (objected to) because the prior art fails to teach that the phenol groups of the aryl alkoxylated phosphates are not substituted with alkyl groups.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication should be directed to Cephia Toomer at
telephone number (703) 308-2509.

Cephia Toomer/om
February 10, 2000


JACQUELINE V. HOWARD
PRIMARY EXAMINER
GROUP 1100